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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/041,538	03/11/1998	DENIS MENARD	1948-4293USI	3407

7590 03/27/2002
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

SINGH, ARTI R

ART UNIT	PAPER NUMBER
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1771

26

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/041,538	MENARD ET AL.	
	Examiner	Art Unit	
	Ms. Arti R. Singh	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11,25,28 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,25,28 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and accompanying remarks filed on 01/22/2002. Applicant's amendment's to the specification and the claims have been entered. The rejection made under 35 USC § 103 (Bortz in view of Suzuki) has been withdrawn. All previously made rejections are maintained and made final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7, 9-11, 25, 28 & 33-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claims 1 & 33 the range percentages claimed do not add up to 100%. You would have to use a maximum of both the weight of the mat and the maximum percentage of the resin to have a composite equaling 100%. If 20 % of the nonwoven fibers were used and 60% of resin was used to make the composite, what makes up the rest 20% of the composite? Is there a third component that is being claimed? Since all the dependant claims bear dependencies to claims 1 & 33 they are rejected to as being dependent upon a rejected base claim. To further elaborate on this previously made rejection (restated for convenience to Applicant) the Examiner understands that the language used is open ended, however if the percentages do not equate to 100%. The claim defines an incomplete article/composition. If there are indeed fillers or particulates within the

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composite then the claim should clearly recite the probable missing component (s) by perhaps using language such as "resin and fiber are found in a specific proportions with an additional substance" and then state the weight of the materials to be used. Currently the claims states a frictional material having approximately 20-40% by weight of the mat and approximately 40-60% of the thermosetting resin. This eludes one skilled in the art to perceive that the composite could be either 40% fiber and 60% resin which would meet the limitation or it could be 30% nonwoven fiber, 30 % filler and 40% resin and the limitations would still be met therefore, a little more clarification is required. If this makes position is not understood, the Examiner invites Applicant to request or to discuss and clarify the reasoning relied upon.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-7, 9-11, 25, 28 & 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.P. 5,646,076 to Bortz. As set forth in the previous office action in paragraph 6.

Response to Arguments

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7. Applicant's arguments filed 01/22/2002 have been fully considered but they are not persuasive. With regards to Applicant's arguments of indefiniteness, as set forth above the Examiner feels that the claim language used does not define the article. If a claim uses positive limitations to define or provide for an unrecited element or requires an additional element, material or composition then the claim must specify what that is or at least provide "room" by stating that there could be additional elements that would make the equation complete.

With regards to the arguments that the Bortz reference does not teach examples such as what Applicant claims is incorrect. The Bortz patent in its Examples shows many different percentage ranges in terms of the fiber and resin contents, hence modifying these percentages would depend on the end use of the frictional composite and thus modifying the percentage to a optimum working range would only involve routine skill in the art. However, in Example 15 the unexpected variables that Applicant argues are found here. The example can have a maximum of 60% fiber which would then make the rest of the composite be either a mixture of the rein and particulates or just the resin and would still meet Applicant's limitations of claim 1. Hence the rejections are maintained and made final.

8. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Arti Singh, whose telephone number is (703) 305-0291. The Examiner can normally be reached Monday through Friday from 8 AM to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor Mr. Terrel Morris, can be reached at (703) 308-2414. A Facsimile center has been


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